

The Office Action Page 3, lines 11-13 acknowledges that the Deegan et al. patent does not explicitly disclose a flash erase file for erasing flash memory contents. However, the office action then alleges that the Moser et al. patent inherently discloses a program file for erasing contents of memory in the peripheral device. Applicant respectfully disagrees. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The Moser et. al. patent does disclose a method for erasing contents of memory in a peripheral device; however, the method disclosed is different from what is claimed by the pending claims. In particular, the Moser et. al. patent discloses a method of erasing flash memory for an upgrade of operating system firmware in a remote measurement unit:

Since modification of the content of flash memory requires an erasure of a complete block or bank of memory and then a rewriting of new data into the erased memory space, the *host processor* next proceeds to erase each block of flash memory of the 'inactive' operating system which is to receive a 'target' firmware upgrade. The upgrade software is then written into the erased blocks of the inactive memory.

(Col. 3, lines 45 – 51, emphasis added)

Thus, according to the Moser et al. patent, the content of the flash memory are erased by the host processor, not by using a flash erase file that is part of an upgrade package. The Moser et. al. patent does not suggest or teach the use of a flash erase file to erase memory locations of a peripheral device as is recited in pending claim 1. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)(reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art). The Moser et. al. patent does

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disclose (1) a "functionality/use descriptor" file that tells an installer what may and what may not be installed for a particular remote measurement unit (Col.3, lines 28-31), and (2) a bank descriptor table that details the contents of firmware versions currently stored in flash memory systems of a remote measurement unit (Col. 3, lines 38-40), but does not disclose or suggest the claim limitations missing from the Deegan et. al. patent. In particular, there is no disclosure or suggestion that the Moser patent utilizes a flash erase file to prepare the remote measurement unit for an upgrade. Therefore, the combination of Deegan et. al. and Moser et. al. patents does not suggest the subject matter recited in independent claims 1, 9, 18, and 25.

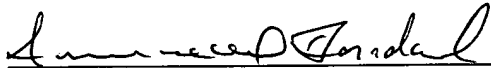
Conclusion

In view of the foregoing remarks, applicant respectfully requests withdrawal of the rejections of claims 1-6, 8-15, 17-22, and 24-29.

Please apply any charges or credits to deposit account 06-1050, referencing Attorney Docket No. 10559-371001.

Respectfully submitted,

Date: 6/17/04



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